

REMARKS

Claims 1-22 and 24-43 are pending in this application. Claims 14-20 have been withdrawn by a Restriction Requirement. By this Amendment, claims 42 and 43 are added. No new matter is added by this Amendment, support for new claims 42 and 43 being found in the original specification at, for example, page 6, lines 1-8 and page 7, lines 1-4.

In view of the foregoing amendments and the following remarks, reconsideration of this application is respectfully requested.

I. Restriction Requirement

Applicant affirms the election of claims 1-13, 21, 22 and 25-41 (Group I). The Restriction Requirement is respectfully traversed.

According to the Restriction Requirement, the invention of Group I, drawn to hot marking method, is related to the invention of Group II, drawn to a multilayer structure, as process of using and product. It was asserted that the inventions are distinct because the product could be used in a materially different process "such as wherein the layer of varnish that hardens under the effect of radiation is fully cured prior to transfer of the decoration to the substrate."

According to MPEP §803, there are two requirements that must be met before a proper Restriction Requirement may be made. These two requirements are: "The inventions must be independent . . . or distinct as claimed; and there must be a serious burden on the Examiner if restriction is not required . . ." (emphasis added). Applicant respectfully submits that the Office Action has failed to establish the second requirement set forth in MPEP §803, that a serious burden exists on the Examiner if restriction is not required between the Groups of claims.

In the present application, the method recited in claims 1 and 26 of Group I includes all of the structural limitations of the multilayer structure of claim 14 of Group II. Thus, the

search for the subject matter of the elected claims of Group I will necessarily include a search for the subject matter of the claims of Group II. This is even more so the case with respect to claim 20 of Group II, which specifically depends from claim 1.

In view of this, it is respectfully asserted that the search and examination of the entire application could be made without serious burden. MPEP §803 states that "If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (emphasis added). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicant and duplicative examination by the Patent Office.

For all the foregoing reasons, reconsideration and withdrawal of the Restriction Requirement are respectfully requested.

II. Rejection Under 35 U.S.C. §102(e)

Claims 1, 6, 9, 10, 24-26, 31, 34, 35 and 41 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by JP 01-20249 to Doi (hereinafter "Doi") for consistency with the identification of this reference in the Office Action. This rejection is respectfully traversed.

The hot marking methods of each of claims 1 and 26 include a step of "applying pressure and heat to the backing layer at a location where its desired to transfer the decoration layer onto the article, the varnish layer being transferred locally onto the article together with the decoration layer" (emphasis added). Doi fails to teach or suggest a hot marking method including such a process step.

Specifically, Doi discloses a transfer sheet which may be transferred onto an article using a heating roller at 200°C. The process described in Doi thus results in transfer of the entirety of the thin metallic film layer and protective layer of the transfer sheet to the article. Doi thus does not teach or suggest applying pressure and heat to a backing layer only at the

location where it is desired to transfer the decoration layer onto an article and in which the varnish layer is transferred locally onto the article together with the decoration layer.

For at least this reason, Doi clearly fails to teach, and therefore clearly fails to anticipate, the hot marking method as recited in present claims 1 and 26.

Further, new dependent claims 42 and 43 each recite that a gilding iron having portions in relief corresponding to the pattern to be made is used to apply pressure and heat to the backing layer. Doi describes a uniform roller, and does not teach or suggest using a gilding iron having portions in relief to apply pressure and heat to the backing layer so as to effect transfer of a desired pattern to the article. Doi thus also fails to teach, and therefore fails to anticipate, the further limitations of dependent claims 42 and 43.

For at least the foregoing reasons, Applicant respectfully submits that Doi does not anticipate the hot marking method as recited in independent claims 1 and 26 and claims dependent therefrom. Reconsideration and withdrawal of this rejection are respectfully requested.

III. Rejections under 35 U.S.C. §103(a)

A. Claims 12 and 37

Claims 12 and 37 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Doi in view of U.S. Patent No. 4,215,170 to Vilaprinyo Oliva (hereinafter "Vilaprinyo Oliva"). This rejection is respectfully traversed.

In this rejection, the Patent Office recognized that Doi does not teach or suggest how a metal design layer may be formed. However, the Patent Office alleged that it would have been obvious from the teachings of Vilaprinyo Oliva to have utilized vacuum metallization for this purpose.

Applicant respectfully submits that even if the teachings of Vilaprinyo Oliva were to have been combined with the teachings of Doi in the manner alleged in the Office Action, the

presently claimed invention still would not have been achieved. This is because Vilaprinyo Oliva remedies none of the deficiencies of Doi discussed above. Thus, the combined teachings of Doi and Vilaprinyo Oliva would not have led one of ordinary skill in the art to the hot marking method of independent claims 1 and 26.

For at least the foregoing reasons, Applicant respectfully submits that neither Doi nor Vilaprinyo Oliva, whether taken singly or in combination, teach or suggest the presently claimed hot marking methods. Reconsideration and withdrawal of this rejection are respectfully requested.

B. Doi In View of Reed

Claims 2, 4, 5, 7, 8, 11, 13, 21, 27, 29, 30, 32, 33, 36, 38 and 39 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Doi in view of U.S. Patent No. 4,294,641 to Reed (hereinafter "Reed"). This rejection is respectfully traversed.

The Patent Office turned to the teachings of Reed as allegedly suggesting the chemical make-up of a resin layer curable by UV radiation. It was further alleged that Reed suggested substitution of the metallic decorated layer of Doi with a printed in decoration layer.

However, Applicant respectfully submits that even if the teachings of Doi and Reed were to have been combined in the manner alleged in the Office Action, the hot marking methods of claims 1 and 26 still would not have been achieved. Like Doi discussed above, Reed also fails to teach or suggest a hot marking method in which pressure and heat are applied to the backing layer at a location where it is desired to transfer the decoration layer onto an article and in which the varnish layer is transferred locally onto the article together with the decoration layer.

For at least the foregoing reasons, Applicant respectfully submits that neither Doi nor Reed, whether taken singly or in combination, would have led one of ordinary skill in the art

to the presently claimed invention. Reconsideration and withdrawal of this rejection are respectfully requested.

C. Doi In View of Reed and Further In View of Hekal

Claims 3 and 28 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Doi in view or Reed, and further in view of U.S. Patent No. 5,581,978 to Hekal et al. (hereinafter "Hekal"). This rejection is respectfully traversed.

The Patent Office turned to the teachings of Hekal as allegedly suggesting the use of a UV or thermally curable resin based on a cationic system.

Beyond the fact that this rejection is improper and that none of the references teach or suggest the hindsight picking and choosing combination made by the Patent Office, Applicant respectfully submits that even if one of ordinary skill in the art were to somehow have combined the teachings of the references in the manner alleged in the Office Action, the hot marking methods of claims 1 and 26 would not have been achieved. Here again, like Doi and Reed discussed above, Hekal also fails to teach or suggest a hot marking method that includes the step of applying pressure and heat to a backing layer at a location where it is desired to transfer a decoration layer onto an article and in which the varnish layer is transferred locally onto the article together with the decoration layer.

For at least the foregoing reasons, Applicant respectfully submits that none of Doi, Reed or Hekal, whether taken singly or in combination, teach or suggest the presently claimed invention. Reconsideration and withdrawal of this rejection are respectfully requested.

D. Doi In View of Reed, and Further In View of Howard

Claims 22 and 40 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Doi in view of Reed, and further in view of U.S. Patent No. 4,133,723 to Howard (hereinafter "Howard"). This rejection is respectfully traversed.

The Patent Office further turned to the teachings of Howard as allegedly suggesting a transfer layer comprised of low molecular weight oligomers having a molecular weight in the range of from about 800 to about 2000.

Applicant respectfully submits that Howard, like Doi and Reed discussed above, similarly fails to teach or suggest a hot marking method that includes a step of applying pressure and heat to a backing layer at a location where it is desired to transfer a decoration layer onto an article and in which the varnish layer is transferred locally onto the article together with the decoration layer, as recited in present claims 1 and 26. Thus, Applicant respectfully submits that even if the references were to have been combined as alleged in the Office Action, one of ordinary skill in the art still would not have been led to the presently claimed hot marking methods.

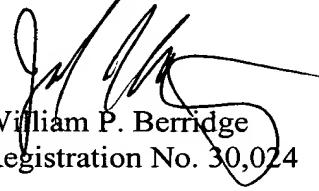
For at least the foregoing reasons, Applicant respectfully submits that none of Doi, Reed or Howard teach or suggest the presently claimed invention, whether the references are taken singly or in combination. Reconsideration and withdrawal of this rejection are respectfully requested.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-22 and 24-43 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,


William P. Berridge
Registration No. 30,024

Joel S. Armstrong
Registration No. 36,430

Christopher W. Brown
Registration No. 38,025

WPB:JSA:CWB/rav

Date: October 9, 2003

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

**DEPOSIT ACCOUNT USE
AUTHORIZATION**
Please grant any extension
necessary for entry;
Charge any fee due to our
Deposit Account No. 15-0461